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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,759	10/22/2003	William H. Advocate	FIS920030224US1	5365
23550	7590	12/15/2008		
HOFFMAN WARNICK LLC				
75 STATE STREET				
14TH FLOOR				
ALBANY, NY 12207				
EXAMINER				
BECKLEY, JONATHAN R				
ART UNIT		PAPER NUMBER		
2625				
NOTIFICATION DATE		DELIVERY MODE		
12/15/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

Office Action Summary

Application No.

10/690,759

Applicant(s)

ADVOCATE ET AL.

Examiner

JONATHAN R. BECKLEY

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-6,8-10,14-17 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,8-10,14-17 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/22/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1, 4-6, 8-10, 14-17 and 20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 4-6 and 8** are rejected under **35 U.S.C. 103(a)** as being unpatentable over obviousness by **Shaffer et al. (U.S. Patent # 6,239,881)** combined with **Hoffman, Jr. et al. (US Patent # 6,122,657)**, and further in view of **Shimura et al. (US Publication 2004/0105689)**.

3. Regarding **Claim 1**, **Shafer** teaches a method of handling a facsimile image received by a facsimile system (**Column 1, lines 6-7**), the method comprising the steps of:

comparing (**step 506, Figure 2**) a junk fax image (**'unacceptable' station identifiers**) stored in a junk fax database (**list of station identifiers**) to an incoming facsimile image (**station identifier**) (**Column 4, lines 4 – Column 5, lines 4; See Figures 2 and Figures 5**);

disposing (**See Figure 2, step 212; See Figure 5, step 518**) of the incoming facsimile image in the case that the junk fax image matches at least a portion of the incoming facsimile image (**Column 3, lines 63-65; Column 5, lines 17-19; See Figure 2; See Figure 5**);

wherein if a match does not exist (**See Figure 5, step 508, “No”**), the method further comprises:

determining whether the incoming facsimile is of a junk fax (**See Figure 5, steps 508-510**);

wherein the determining includes:

displaying at least a portion of the incoming facsimile image before outputting the image (**See Figure 5, step 510**), wherein the outputting includes printing the incoming facsimile image through the facsimile system (**Column 5, lines 1-7, and lines 14-17; See Figure 5, step 510**); and

allowing a recipient to view the at least a portion of the displayed image to determine whether the incoming facsimile image is of a junk fax (**Column 5, lines 1-18**); and

saving at least a portion of the incoming facsimile image as a junk fax image in the junk fax database in the case that the incoming facsimile image is of a junk fax (**Column 5, lines 8-9**).

Shaffer does not directly teach using images in a method of handling a facsimile image received by a facsimile system, the method comprising the steps of:

disposing of the incoming facsimile image in the case that the junk fax image matches at least a portion of the incoming facsimile image;

calculating a toner count of at least a portion of the incoming facsimile image; and processing the incoming facsimile image in the case that the toner count is below a threshold.

Shaffer combined with Hoffman does teach using images in a method of handling a facsimile image received by a facsimile system, the method comprising the steps of:

disposing of the incoming facsimile image in the case that the junk fax image matches at least a portion of the incoming facsimile image (**Column 30, lines 9-46; Column 30, lines 36-46**);

calculating a toner count of at least a portion of the incoming facsimile image (**Column 30, lines 36-46**); and

processing the incoming facsimile image in the case that the toner count is below a threshold (**Column 30, lines 42-46**). (Noted: At the time of the invention it is well known to those skilled in the art that facsimile systems can be produced through the internet and html with internet facsimile machines in the same operating steps as through a telephone lines. Also Noted: the filtering system of Hoffman calculates the size of an image, and checks it against a maximum image size, threshold.)

Shaffer and Hoffman are combinable because they are all from the same art and classification of filtering of incoming data within a communication system.

Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Shaffer combined with Hoffman, so to apply the internet filtering of bad or unwanted images to a facsimile system in order to filter out identifiers such as images that are not wanted according to a list and thresholds.

Shaffer combined with Hoffman does not teach a toner count is used as a maximum size in a method of handling a facsimile image received by a facsimile system, the method comprising the steps of:

calculating a toner count of at least a portion of the incoming facsimile image; and
processing the incoming facsimile image in the case that the toner count is below a threshold.

Shaffer combined with Hoffman further in view of Shimura does teach a toner count is used as a maximum size in a method of handling a facsimile image received by a facsimile system, the method comprising the steps of:

calculating a toner count of at least a portion of the incoming facsimile image; and processing the incoming facsimile image in the case that the toner count is below a threshold **(Paragraph 12; Paragraph 15, Paragraph 197 and 200; Paragraphs 293-295; and Paragraph 390).**

Shaffer and Hoffman and Shimura are combinable because they are all from the same art and classification of processing user data in response to a demand to transfer data between the computers while detecting for spam within an image processing device which uses toner thresholds as determining factors to further continue processing.

Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Shaffer combined with Hoffman with the teachings of Shimura to further develop the condition controlling process of the image processing apparatus using determined parameters expressing the state of toner.

2. (Canceled).

3. (Canceled).

Regarding **Claim 4, Shaffer combined with Hoffman further in view of Shimura** discloses wherein the junk fax image includes at least a portion of an analyzed facsimile image

that has been designated as a junk fax (**Shaffer: Column 5, lines 4-7**)(**Hoffman: Column 3, lines 34-46**).

Regarding **Claim 5, Shaffer combined with Hoffman further in view of Shimura** wherein the junk fax image database includes a plurality of junk fax images (**Shaffer: list of identifiers, Column 5, lines 1-2**), and the step of disposing occurs in the case that at least one of the plurality of junk fax images matches at least a portion of the incoming facsimile image (**Shaffer: Column 3, lines 63-65**).

Regarding **Claim 6, Shaffer combined with Hoffman further in view of Shimura** wherein the disposing step includes one of:

- a) deleting the incoming facsimile image; and
- b) terminating communication of the incoming facsimile image to the facsimile system

(**Shaffer: See Figure 2, step 212; See Figure 3, step 310**).

7. (Canceled).

8. (Original) The method of claim 1, wherein the incoming facsimile image is generated by scanning a hard copy document (**Shaffer: See Figure 6, sender's facsimile device; Noted: It can be seen in the figure of the sender's device is a machine which scans hard copies.**)

4. Claims 9, and 14-16 are rejected under **35 U.S.C. 103(a)** as being unpatentable over obviousness by **Shaffer et al. (U.S. Patent # 6,239,881)** combined with **Hoffman, Jr. et al. (US Patent # 6,122,657)**.

5. Regarding Claim 9, Shafer teaches a facsimile system (**Figure 6**) comprising:
a receiver (**data receptor 610**) configured to receive an incoming facsimile image (**Column 5, lines 23-26**); and

a junk fax analyzer (**Processor 614**) comprising:
a comparator configured to compare a junk fax image to the incoming facsimile image (**Column 5, lines 26-37**);

a disposal configured to dispose of the incoming facsimile image in the case that the junk fax image matches at least a portion of the incoming facsimile image (**Column 5, lines 27-36**); and

a junk fax determinator configured to determine whether the incoming facsimile image is a junk fax, and save at least a portion of the incoming facsimile image as a junk fax image in a junk fax database in the case that the incoming facsimile image is a junk fax (**Column 5, lines 1-4, and lines 27-47**);

wherein the junk fax determinator includes:

a display configured to display at least a portion of the incoming facsimile image before the image is outputted (**Column 5, lines 37-42**);

wherein the outputting includes printing the incoming facsimile image through the facsimile system (**Column 5, lines 42-43**);

an interface configured to allow a recipient to view the at least a portion of the displayed image to input whether the incoming facsimile image is a junk fax (**Column 5, lines 37-42**); and

a selector configured to allow the recipient to select at least a portion of the incoming facsimile image to be saved as the junk fax image (**Column 3, lines 67 – Column 4, lines 2; Column 5, lines 48-58**).

Shaffer does not directly teach using images in a facsimile system comprising:

a receiver configured to receive an incoming facsimile image; and

a junk fax analyzer comprising:

a comparator configured to compare a junk fax image to the incoming facsimile image.

Shaffer combined with Hoffman does teach using images in a facsimile system comprising:

a junk fax analyzer comprising:

a comparator configured to compare a junk fax image to the incoming facsimile image (**Column 30, lines 9-46; Column 30, lines 36-46**). (Noted: At the time of the invention it is well known to those skilled in the art that facsimile systems can be produced through the internet and html with internet facsimile machines in the same operating steps as through a telephone lines.)

Shaffer and Hoffman are combinable because they are all from the same art and classification of filtering of incoming data within a communication system.

Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Shaffer combined with Hoffman, so to apply the internet filtering of bad or unwanted images to a facsimile system in order to filter out identifiers such as images that are not wanted according to a list and thresholds.

11. (Canceled).

12. (Canceled).

13. (Canceled).

Regarding **Claim 14, Shaffer combined with Hoffman** discloses wherein the junk fax image includes at least a portion of one of: an analyzed facsimile image from a previous communication to the facsimile system and an image of a hard copy document (**Shaffer: Column 5, lines 4-7) (Hoffman: Column 3, lines 34-46)**...

Regarding **Claim 15, Shaffer combined with Hoffman** discloses wherein the junk fax image includes a plurality of junk fax images (**Shaffer: list of identifiers, Column 5, lines 1-2**), and the step of disposing occurs in the case that at least one of the plurality of junk fax images matches at least a portion of the incoming facsimile image (**Shaffer: Column 3, lines 63-65**).

Regarding **Claim 16, Shaffer combined with Hoffman** discloses wherein the disposal includes:

- a) means for deleting the incoming facsimile image; and
- b) means for terminating communication of the incoming facsimile image to the facsimile system (**Shaffer: See Figure 2, step 212; See Figure 3, step 310**).

6. **Claim 17, Shafer** teaches a computer program product comprising a computer useable medium having computer readable program code embodied therein for analyzing an image on a facsimile system, the program product comprising: (**communications program 612, and processor 614; Column 5, lines 27-36**), the program product comprising:

program code configured to comparing (**step 506, Figure 2**) a junk fax image (**'unacceptable' station identifiers**) stored in a junk fax database (**list of station identifiers**) to an incoming facsimile image (**station identifier**) (**Column 4, lines 4 – Column 5, lines 4; See Figures 2 and Figures 5**);

program code configured to dispose (**See Figure 2, step 212; See Figure 5, step 518**) of the incoming facsimile image in the case that the junk fax image matches at least a portion of the incoming facsimile image (**Column 3, lines 63-65; Column 5, lines 17-19; See Figure 2; See Figure 5**); and

program code configured to determine whether the incoming facsimile image is of a junk fax in the case that a match does not exist (**See Figure 5, steps 508-510**), and save at least

portion of the incoming facsimile as a junk image in a junk database in the case that the incoming facsimile image is of a junk (**Column 5, lines 8-9**);

wherein the determining program code includes:

program code configured to display least a portion of the incoming facsimile image before outputting the image (**See Figure 5, step 510**), wherein the outputting includes printing the incoming facsimile image through the facsimile system (**Column 5, lines 1-7, and lines 14-17; See Figure 5, step 510**); and

program code configured to allow a recipient to view the at least a portion of the displayed image to determine whether the incoming facsimile image is of a junk fax (**Column 5, lines 1-18**).

Shaffer does not teach using images in a computer program product comprising a computer useable medium having computer readable program code embodied therein for analyzing an image on a facsimile system, the program product comprising, the program product comprising:

program code configured to comparing a junk fax image stored in a junk fax database to an incoming facsimile image

Shaffer combined with Hoffman does teach using images in a computer program product comprising a computer useable medium having computer readable program code embodied therein for analyzing an image on a facsimile system, the program product comprising, the program product comprising:

program code configured to comparing a junk fax image stored in a junk fax database to an incoming facsimile image (**Column 30, lines 9-46; Column 30, lines 36-46 ;**). (**Noted: At**

the time of the invention it is well known to those skilled in the art that facsimile systems can be produced through the internet and html with internet facsimile machines in the same operating steps as through a telephone lines.

Shaffer and Hoffman are combinable because they are all from the same art and classification of filtering of incoming data within a communication system.

Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Shaffer combined with Hoffman, so to apply the internet filtering of bad or unwanted images to a facsimile system in order to filter out identifiers such as images that are not wanted according to a list and thresholds.

18. (Canceled).

19. (Canceled).

Regarding **Claim 20, Shaffer combined with Hoffman** discloses wherein the disposing program code includes program code configured to conduct one of:

- a) delete the incoming facsimile image; and
- b) terminate communication of the incoming facsimile image to the facsimile system (**Shaffer: See Figure 2, step 212; See Figure 3, step 310**).

10. (Original) The system of claim 9, wherein the junk fax analyzer further comprises a toner count calculator configured to calculate a toner count of at least a portion of the incoming facsimile image.

7. **Claim 10 is rejected under 35 U.S.C. 103(a)** as being unpatentable over obviousness by **Shaffer et al. (U.S. Patent # 6,239,881)** combined with **Hoffman, Jr. et al. (US Patent # 6,122,657)**, and further in view of **Shimura et al. (US Publication 2004/0105689)**.

Shaffer combined with Hoffman a facsimile system comprising:

wherein the junk fax analyzer comprises a toner count calculator configured to calculate a toner count of at least a portion of the incoming facsimile image. **(Hoffman: Column 30, lines 36-46) (Noted: the filtering system of Hoffman calculates the size of an image, and checks it against a maximum image size, threshold.)**

Shaffer combined with Hoffman does not teach a toner count is used as a maximum size in a facsimile system comprising:

wherein the junk fax analyzer comprises a toner count calculator configured to calculate a toner count of at least a portion of the incoming facsimile image.

Shaffer combined with Hoffman further in view of Shimura does teach a toner count is used as a maximum size in a facsimile system comprising:

wherein the junk fax analyzer comprises a toner count calculator configured to calculate a toner count of at least a portion of the incoming facsimile image. **(Paragraph 12; Paragraph 15, Paragraph 197 and 200; Paragraphs 293-295; and Paragraph 390).**

Shaffer and Hoffman and Shimura are combinable because they are all from the same art and classification of processing user data in response to a demand to transfer data between the computers while detecting for spam within an image processing device which uses toner thresholds as determining factors to further continue processing.

Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Shaffer combined with Hoffman with the teachings of Shimura to further develop the condition controlling process of the image processing apparatus using determined parameters expressing the state of toner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN R. BECKLEY whose telephone number is (571)270-3432. The examiner can normally be reached on Mon-Fri: 7:30-5:00 EST (Alternate Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hai Tran can be reached on 571-272-7305. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jonathan R Beckley/

Examiner, Art Unit 2625

12/08/2008

/Twyler L. Haskins/

Supervisory Patent Examiner, Art Unit 2625